Office - Supreme Court, U. S.
FILED
MAY 5 1954
HAROLD B. WILLEY, Clerk

IN THE

# Supreme Court of the United States

OCTOBER TERM—1953

No. 708

COPPER TAN, INC.,

Petitioner,

*v.*

DOUGLAS LABORATORIES CORP.,

Respondent.

## BRIEF FOR RESPONDENT IN OPPOSITION

LESLIE D. TAGGART,
Counsel for Respondent.

New York, N. Y.,
May 4, 1954.

## INDEX


| | PAGE |
|---|---|
| Opinions Below | 1 |
| Jurisdiction | 1 |
| Statement of the Case | 1 |
| ARGUMENT: | |
| I. There is no conflict between the decision below of the Court of Appeals and the decisions of this Court and of other Court of Appeals | 3 |
| II. There is no such presumption as contended by petitioner | 3 |
| III. Where there was no jury and there was no controverted or conflicting evidence on the issue of validity of the trade-mark "Coppertone", the Court of Appeals was under a duty to draw its own inferences and conclusions from the undisputed evidence | 4 |
| Conclusion | 5 |


### TABLE OF CASES


| | |
|---|---|
| Independent Nail & Packing Co., Inc. v. Stronghold Screw Products, Inc., 205 F. 2d 921 (C. A. 7, 1953), cert. den. 346 U. S. 886 | 4 |
| Pastificio Spiga Societa Per Azioni v. De Martini Macaroni Co. Inc., 200 F. 2d 325 (C. A. 2, 1952) | 4 |
| Soy Food Mills, Inc. v. Pillsbury Mills Inc., 161 F. 2d 22 (C. A. 7, 1947), cert. den. 332 U. S. 766 | 5 |
| Stephano Bros. v. Stamatopoulos, 238 Fed. 89, 91 (C. C. A. 2, 1916) | 3 |
| Trade-Mark Cases, 100 U. S. 82, 94 (1879) | 3 |


### STATUTES CITED


| | |
|---|---|
| Trade-Mark Act of 1905, 15 U. S. C. 96 | 4 |
| Trade-Mark Act of 1946, 15 U. S. C. 1072 and 1115a | 4 |

IN THE

# Supreme Court of the United States

OCTOBER TERM—1953

No. 708

COPPER TAN, INC.,

Petitioner,

*v.*

DOUGLAS LABORATORIES CORP.,

Respondent.

## BRIEF FOR RESPONDENT IN OPPOSITION

### Opinions Below

The District Court's opinion is reported at 108 F. Supp. 837 (R. 378a) and the opinion of the Court of Appeals at 210 F. 2d 453 (R. 405a).

### Jurisdiction

The jurisdiction of this Court is invoked by petitioner under 28 U. S. C. 1254(1) and 2101(c).

### Statement of the Case

Respondent (plaintiff below) brought its civil action for trade-mark infringement and for unfair competition. Respondent claimed "Coppertone" as its trade-mark for

suntan oils and lotions and asked for an injunction against petitioner's (defendant below) use of "Copper Tan" as its trade-mark for the same products, as its trade name and for other relief. Petitioner counterclaimed that "Copper Tan" was its trade-mark and sought an injunction against respondent's use of "Coppertone" as its trade-mark and for other relief. During the trial, petitioner withdrew its counterclaim. (The facts are not as stated by petitioner on page 3 of its petition, that respondent started to use "Copper Tan" in 1946 as its trade-mark. Respondent's mark is "Coppertone" and it was first used in 1944; R. 407a.)

The District Court found that secondary meaning had been established in respondent's mark "Coppertone" before petitioner started to manufacture and sell "Copper Tan" in June of 1946 (R. 407a). It found confusing similarity between the two marks. The District Court further found (R. 392a).

> "11. In June of 1946 the officers of the defendant were well aware of the 'Coppertone' reputation and fully intended to capitalize on it for their own profit."

The District Court failed to apply the established law that when secondary meaning is established in a mark, its owner is entitled to an injunction against the subsequent use by another of a confusingly similar mark as a trade-mark and trade name.

The Court of Appeals modified the decision of the District Court and granted the appropriate injunction. It also held that "Coppertone" was a valid common-law trade-mark (R. 407a-410a).

## Argument

The petition for the writ is without merit. Respondent will reply to petitioner's points *seriatim*.

### I

**There is no conflict between the decision below of the Court of Appeals and the decisions of this Court and of other Courts of Appeals.**

Petitioner indicates the correct rule of law, namely, that if it be necessary to prove a secondary meaning to establish trade-mark rights in a word or other symbol, secondary meaning must be established by the time the infringement started. The Court of Appeals followed that rule of law. It showed, as found by the District Court, that respondent had established secondary meaning before petitioner started to market its goods in June 1946 (R. 407a-408a). It then applied the above rule of law and ordered the injunction (R. 410A).

### II

**There is no such presumption as contended by petitioner.**

The existence of a conflict in the circuits on presumptions is only pertinent if there be a presumption. Petitioner claims there is a presumption of invalidity of a trade-mark where an application to register was filed in the United States Patent Office but not prosecuted. Petitioner has cited no authority for such a presumption, because there is no authority. There can be no such presumption because trade-mark rights grow out of use (*Trade-Mark Cases*, 100 U. S. 82, 94, 1879) and are independent of statute and registration (*Stephano Bros.* v. *Stamatopoulos*, 238 Fed. 89, 91, C. C. A. 2, 1916).

Petitioner has cited cases supporting a different presumption, namely, that when a trade-mark registration is issued by the Patent Office, the registration and the trade-mark are presumptively valid. That presumption is provided by statute (Trade-Mark Act of 1905, 15 U. S. C. 96; Trade-Mark Act of 1946, 15 U. S. C. 1072 and 1115a). This different presumption has no applicability in the present case.

## III

**Where there was no jury and there was no controverted or conflicting evidence on the issue of validity of the trade-mark "Coppertone", the Court of Appeals was under a duty to draw its own inferences and conclusions from the undisputed evidence.**

The evidence, both testimonial and documentary, on the validity of "Coppertone" was not in dispute. There was no question of credibility. The District Court held that "Coppertone" was descriptive, but stated with candor that determining whether a word is suggestive or descriptive "admits of differences of opinion" (R. 381a). Since there was no question of veracity of witnesses or conflicting evidence and the documents were before the Court of Appeals, it was under a duty to determine whether in its opinion "Coppertone" was or was not a valid trade-mark. It performed this duty. Its holding is that "Coppertone" is not descriptive but a valid common-law trade-mark (R. 408a-409a).

The duty of Courts of Appeals to draw their own inferences and conclusions from uncontroverted facts is a regular and normal responsibility of such courts.

> *Pastificio Spiga Societa Per Azioni* v. *De Martini Macaroni Co. Inc.*, 200 F. 2d 325 (C. A. 2, 1952);
> *Independent Nail & Packing Co., Inc.* v. *Stronghold Screw Products, Inc.*, 205 F. 2d 921 (C. A. 7, 1953), cert. den. 346 U. S. 886;

*Soy Food Mills, Inc.* v. *Pillsbury Mills Inc.*, 161 F. 2d 22 (C. C. A. 7, 1947), cert. den. 332 U. S. 766.

In each of the above cases, the District Court had held the trade-mark in issue to be invalid and the Courts of Appeals reversed such holding.

The cases cited by petitioner concern the matter of credibility of witnesses and conflicting evidence, where the District Court's findings are accepted unless clearly erroneous. Such cases are inapplicable here where there is no conflict of evidence or credibility of witnesses involved in the question of the validity of the trade-mark.

## Conclusion

Each of the three points raised by petitioner in its petition and brief are without merit and are inapplicable to the facts of this case. Even if they were applicable here, none of them raise any issue of general public interest. This case is the usual trade-mark and unfair competition case where a defendant (petitioner) knowing of the success of a product of a plaintiff (respondent) adopted and used a trade-mark and trade name almost identical with the plaintiff's for the same goods. After an injunction has been ordered against it, petitioner still wants to trade upon the respondent's reputation and goodwill—hence the petition here. The petition for certiorari should be denied.

Respectfully submitted,

LESLIE D. TAGGART,
Counsel for Respondent.

New York, N. Y.,
May 4, 1954.